REMARKS

Claims 1-11 are currently pending in the application. Certain purely formal amendments to the Specification have been made in response to an objection raised by the Examiner. No new matter is added.

The claimed invention addresses a problem in Voice over Internet Protocol ("VoIP") telephony involving the use of public and private Internet Protocol ("IP") addresses in connection with communications between the Internet and one of a plurality of telephones connected to the Internet via a Local Area Network ("LAN").

A private IP address may be assigned to each of a plurality of telephones 200, 201 connected to a LAN 1, and the addressing of each such telephone may be converted between a private IP and a global IP address. A router 3 with Network Address Translator ("NAT") functionality may be used to perform the necessary conversion and employed to enable a LAN-connected telephone 200, 201 to call an external telephone 510 over the Internet 2. A LAN-connected telephone 200, 201 may, however, be unable to receive a call directly from an external telephone 510 connected to the Internet 2, even if the caller using the external telephone 510 knows the private IP address of the internal telephone 200, 201 within the LAN 1, because the operation of a security mechanism known as a firewall may prevent an external telephone 510 from directly addressing telephones 200, 201 connected to the LAN 1. In addition, a private IP address would not be recognized by the Internet name server 501.

To solve this problem, the claimed invention provides for a telephone controller 100 comprising: an IP address allocating circuit 122 which allocates a private IP address to each of a plurality of LAN-connected telephones 200, 201; a memory 130 which stores a table 131 of the correspondence between the ID 412 of each LAN-connected telephone 200, 201 and its private IP address; and a control circuit 110 which controls the interchange between the plurality of LAN-connected telephones 200, 201 and the Internet 2 using such private IP addresses. Such telephone controller 100, which is placed between the router 3 and a LAN-connected telephone 200 (Figure 8), makes it possible for a LAN-connected telephone 200, 201 to receive a direct call from an external telephone 510 connected to the Internet 2, provided the external caller employs the ID 412 recognized by the telephone

controller 100. Such ID 412 includes the domain name 302 of the telephone controller 100, recognizable by the Internet name server 501, and identification information (which may include a user name 300 and extension telephone number 301), recognizable by the telephone controller 100.

The Examiner has rejected Claim 2 under 35 U.S.C. § 112 on the ground that there is insufficient basis for the limitation "the ID received via the Internet" in the claim. In addition, the Examiner has rejected Claims 1 and 10 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,496,867 to Beser et al. Finally, the Examiner has rejected Claims 1-11 under 35 U.S.C. § 103(a), with Claims 1-3, 6, and 8-11 being rejected as unpatentable over U.S. Patent No. 6,731,642 to Borella et al. in view of Beser et al., and Claims 4-5 and 7 being rejected as unpatentable over Borella et al. in view of Beser et al. and further in view of Chimura et al. As discussed below, Applicant respectfully traverses all such rejections.

<div align="center">Rejection of Claim 2 Under 35 U.S.C. § 112</div>

The Examiner has rejected Claim 2 under 35 U.S.C. § 112 on the ground that the Specification does not provide sufficient antecedent basis for the limitation "the ID received via the Internet" in Claim 2. Applicant respectfully traverses on the ground that antecedent basis for the limitation "the ID received via the Internet" may be found in the Specification at page 8, line 14 through page 9, line 19, as well as in Figure 5. Applicant thus respectfully submits that the limitations of Claim 2 have sufficient antecedent basis in the Specification should be allowed.

<div align="center">Rejection of Claims 1 and 10 Under 35 U.S.C. § 102(e)</div>

The Examiner has rejected Claims 1 and 10 under 35 U.S.C. § 102(e) as anticipated by Beser et al. Applicant respectfully traverses on the basis that Claims 1 and 10 are not anticipated by Beser et al. For example, among other things, the problem addressed by Claims 1 and 10, which relates to penetrating a security firewall to directly address, or call, a LAN-connected VoIP telephone from outside the LAN, does not present itself in Beser et al., which relies on connections made through a tunneling association negotiated by means of a trusted third-party network device. Discussion of security in Beser et al. lacks consideration of this issue and appears to be limited to the desirability of preventing eavesdropping.

Beser et al. describes a system and method to negotiate private network addresses for initiating tunneling associations through private and/or public networks.

In Beser et al., such tunneling associations are initiated through a trusted third-party network device 30 which, apparently because of its "trusted" security status, does not implicate the firewall problem addressed by the claimed invention. The invention of Beser et al. will permit telephones connected to a private network 20 to receive calls originating outside the network, to the extent such calls are channeled through a third-party network device 30 recognized as trusted.

Beser et al. does not claim to enable network-connected telephones to receive calls originating outside the private network 20, except to the extent calls may be received from telephones establishing a connection through a trusted third-party network device 30. (Beser et al., Figures 1, 6, and 9) Claims 1 and 10 of the claimed invention, by contrast, permit telephones 200, 201 connected to a LAN 1 to receive calls from a telephone 510 connected to the Internet 2. Thus, the tunneling association of Beser et al. is not analogous to aspects of the claimed invention, because the claimed invention does not require negotiation of an association between two networks via a trusted third-party network device 30. (Cf. Beser et al., Figure 6)

The network device of Beser et al. is not analogous to the telephone controller 100 of the claimed invention. The network device of Beser et al. is external to the private network (Beser et al., Figure 1), whereas the telephone controller 100 of Claims 1 and 10 is internal to (and thus inside the firewall of) the LAN 1 (Figures 7 and 8). Thus, even though Beser et al. may discuss the addressing of calls to VoIP-enabled telephones within a private network 20 from outside of the network using private IP addresses (Beser et al., Figure 5), there is no discussion of doing so through a telephone controller 100 like that of Claims 1 and 10 of the claimed invention. As noted above, Beser et al. permits VoIP-enabled telephones within a private network 20 to receive calls from telephones outside the network as long as the calling telephones are connected to a trusted third-party network device 30, but Beser et al. does not discuss the possibility of network telephones receiving calls from outside telephones which lack such a connection to a trusted third-party network device.

There is no discussion in Beser et al. of employing an ID 412 which includes the domain name 302 of the telephone controller 100, recognizable by the Internet name server 501, along with identification information (which may include a user name 300 and extension telephone number 301), recognizable by the telephone controller 100. The specification of Beser et al. instead discusses the possible use of

domain names to "initiate the VoIP association" (Beser et al., column 10, line 22)
Unlike Beser et al., however, neither Claim 1 nor Claim 10 provides for the
negotiation of a tunneling, or VoIP, association through a trusted third-party network
device (Beser et al., Figures 6, 9). Instead, Claims 1 and 10 provide that a
telephone 510 outside the LAN 1 may directly call any of a plurality of
LAN-connected telephones 200, 201 by employing an ID 412 which includes domain
name 302 and additional identification information (which may include a user
name 300 and extension telephone number 301) (Claim 1, *supra*, lines 10-11;
Claim 10, lines 7-8 and 12-15; Figure 5; Specification at page 8, line 14 through
page 9, line 1). Thus, the statement in the specification of Beser et al. that one
embodiment of that invention may employ a "unique identifier [which] is any of a
dial-up number, an electronic mail address, or a domain name" (Beser et al. at
column 10, lines 39-41) does not anticipate the ID 412 of Claims 1 and 10, because
inter alia no provision is made for the "unique identifier" of Beser et al. to enable an
outside telephone 510 to call an inside telephone 200, 201 without first negotiating a
tunneling association through a trusted third-party network device (Beser et al.,
Figures 6, 9).

The edge router discussed by Beser et al. is not analogous to the control
circuit 110 of the claimed invention, because *inter alia* such edge router as defined by
Beser et al. is external to the private network 20 (Beser et al., column 4, lines 19-24).
The control circuit 110 of Claims 1 and 10, by contrast, is to be found within the
telephone controller 100, which is inside the LAN 1. (Figures 7 and 8) Moreover,
the edge router differs from the control circuit 110 in function, in that "[a]n edge
router routes data packets between one or more networks such as a backbone network
(e.g., public network 12) and Local Area Networks (e.g., private network 20)" (Beser
et al., column 4, lines 21-24), while the control circuit 110 of Claims 1 and 10 is a
part of a telephone controller 100 which acts as an interchange between a plurality of
LAN-connected telephones 200, 201 and the Internet 2 using private IP addresses.
(Claim 1, *supra*, lines 2-3, 8-9; Claim 10, *supra*, lines 4, 8-9; Figures 7 and 9;
Specification at page 3, lines 11-13; page 5, lines 21-27)

Applicant thus respectfully submits that Claims 1 and 10 are not anticipated
by Beser et al.

<u>Rejection of Claims 1-3, 6, and 8-11 Under 35 U.S.C. § 103(a)</u>

The Examiner has rejected Claims 1-3, 6, and 8-11 under 35 U.S.C. § 103(a) as unpatentable over Borella et al. in view of Beser et al. Applicant respectfully traverses on the basis that the combination of Borella et al. and Beser et al. would not result in the claimed invention.

Like Beser et al., Borella et al. does not address the difficulty of penetrating a security firewall to directly address, or call, a LAN-connected telephone from outside the LAN. Discussion of security in Borella et al. appears to be limited to discussion of the desirability of preventing unauthorized persons from gaining access to the system to make unauthorized telephone calls. Borella et al. describes a communication system 10 for Internet telephony, and a method relating to such a system, whereby a caller station 24 is connected to a first edge network 14 via a first telephony interface while a callee station 26 is connected to a second edge network 16 via a second telephony interface. An intermediate network 12, which may be the Internet, is connected to the first edge network 14 via a first router 18 and is connected to the second edge network 16 via a second router 20. To the first edge network 14 is connected a first telephony interface 22, to which is connected the caller station 24. To the second edge network 16 is connected a second telephony interface 24, to which is connected the callee station 26. The first router 18 may initiate a call in a process that employs a callee station number associated with the callee station 26, which is preferably a conventional telephone number. A first gatekeeper 30, which controls the first router 18, and a second gatekeeper 32, which controls the second router 20, together mediate the process of setting up a call. A back end server (Borella et al., Figure 3), in communication with the first gatekeeper 30 and the second gatekeeper 32, stores the addresses and station numbers needed to set up the call. During the call, the first router 18 performs network address translation to transmit signals between the first edge network 14 and the intermediate network 12, while the second router 20 performs network address translation to transmit signals between the second edge network 16 and the intermediate network 12.

Claims 1 and 10. The gatekeeper of Borella et al. is not analogous to the telephone controller 100 of independent Claims 1 and 10. The gatekeeper is external to the edge network of Borella et al. (which the Examiner finds analogous to the LAN 1 of Claims 1 and 10), while the telephone controller 100 is internal to the

LAN 1 of Claims 1 and 10 (Figures 7 and 8). This distinction between Borella et al. and Claims 1 and 10 appears to be the case even when "the embodiment [of Borella et al.] whereby the gateway and the router are part of the same device is assumed" (Office Action at 5). While Borella et al. may describe means for handling the IP addressing of VoIP telephones, as the Examiner states, this is done without apparent consideration as to how to permit a telephone outside the LAN to call a LAN-connected telephone without being stopped by the firewall, as discussed above. Thus, there is no basis for finding the addressing features of Borella et al. to be analogous to the addressing features of the claimed invention. Recognizing that the ID 412 of Claims 1 and 10 has no analog in Borella et al., the Examiner relies on Beser et al. to make up for the deficiency. As discussed above in connection with the rejection of Claims 1 and 10 under 35 U.S.C. § 102(e), however, Beser et al. provides for the negotiation of a tunneling, or VoIP, association through a trusted third-party network device (Beser et al., Figures 6, 9) and does not discuss techniques for potentially calling through the firewall of a LAN 1, other than by means of such an association. While the specification of Beser et al. discusses the possible use of "a dial-up number, an electronic mail address, or a domain name" as the "unique identifier" for a VoIP-enabled telephone (Beser et al., column 10, lines 39-41), there is no discussion of employing an ID 412 that includes the domain name 302 of the telephone controller 100, recognizable by the Internet name server 501, along with identification information (which may include a user name 300 and extension telephone number 301), recognizable by the telephone controller 100 of the LAN 1. Applicant thus submits that Claims 1 and 10 are patentable over Borella et al. in view of Beser et al.

Claims 2 and 11. The Examiner has found dependent Claims 2 and 11 to be unpatentable over Borella et al. because "Borella discloses the limitation of extracting identification information and searching the table to obtain the private IP address in the network address translation described in lines 49-53 of column 10." (Office Action at 6) In the passage from Borella et al. cited by the Examiner, however, the function of converting public IP addresses to private IP addresses is expected to be done by the router. It is acknowledged in the Specification of the claimed invention that address conversions may be done by a NAT-enabled router 3; however, use of a NAT-enabled router 3 does not solve the problem of avoid having the firewall block

calls to inside telephones 200, 201 connected to the LAN 1 from an outside telephone 510 connected to the Internet 2. The use of an ID 412 from which identification information may be extracted by a telephone controller 100 connected to the LAN 1, as in Claims 2 and 11, is therefore not contemplated by Borella et al. and is a solution for a problem not contemplated by Borella et al. Applicant thus respectfully submits that Claims 2 and 11 are patentable over Borella et al.

Claim 3. The Examiner has found dependent Claim 3 to be unpatentable over Borella et al. because "Borella discloses the limitation that the control circuit notifies the allocated IP address to the telephone in step 104 of figure 3. As described in lines 24-26 of column 9, this message includes the private callee address." (Office Action at 6) This step is distinguishable from Claim 3 in that the notification step of Claim 3 is done by the control circuit 110, which is part of the telephone controller 100, which is a device connected to the LAN 1 and which is clearly distinct from the router 3 (Figures 7 and 8). In Figure 3 of Borella et al., however, the ring 104 (notification) is initiated by the second router. The claimed invention clearly distinguishes notification by router 3 from notification by telephone controller 100, because the problem of overcoming a firewall when notification is to be made by router 3 is a problem solved in the claimed invention through notification by telephone controller 100. (Specification at page 2, lines 8-20) Notably, Borella et al. does not assert that it permits any VoIP-enabled telephone to place calls to telephones connected to the edge network. Instead, according to Borella et al., two routers must be establish a gatekeeper setup through a back end server in order for such calls to occur. (Borella et al., Figure 3) Applicant thus respectfully submits that Claim 3 is patentable over Borella et al.

Claim 6. The Examiner has found dependent Claim 6 to be unpatentable over Borella et al. because "Borella discloses the limitation that the memory stores a table indicating communication history information for each ID in lines 14-15 of column 8. Here Borella explains the gatekeeper will store the private caller address in order to determine billing information (which requires a history of the communication information)." (Office Action at 6) First, as discussed above in connection with the rejection of Claims 1 and 10 as unpatentable over Borella et al. in view of Beser et al., the ID 412 of the claimed invention is not analogous to features discussed in Borella et al. In addition, the statement in Borella et al. that the "[f]irst gatekeeper 30 stores

the private caller address in order to determine later how the call should be billed" (Borella et al., Specification at column 8, lines 14-15) is not analogous to the provision of Claim 6 of the claimed invention, that the memory 130 of the telephone controller 100 would contain "a table indicating communication history information for each ID." While there may be some generic commonality in terms of storing information relating to VoIP telephone calls, such storage occurs within entirely distinct architectures and for different purposes, as discussed above. Furthermore, the record kept by Borella et al. appears to be limited to outgoing calls (those handled by the first gatekeeper) and is done solely for billing purposes, while the record kept according to Claim 6 appears to include both incoming and outgoing calls ("communication history information for each ID") and is not associated with a limitation as to purpose. Finally, as discussed above, the ID 412 of the claimed invention is not analogous to features discussed by Borella et al. Applicant thus respectfully submits that Claim 6 is patentable over Borella et al.

Claim 8. The Examiner has found dependent Claim 8 to be unpatentable over Borella et al. because "Borella discloses the means for receiving the ID wherein the control circuit stores the ID received from said means in the allocate address messages of Figure 3. These messages contain ID information which are inherently received (transferred from one device to another) and are inherently stored (as discussed above in order to use this information to perform the network address translation)." (Office Action at 7) The control circuit 110 and ID 412 of Claim 8, however, are not analogous to features discussed by Borella et al. In addition, the "allocate address" function in Figure 3 of Borella et al. occurs between a gatekeeper and a router, which means that it occurs outside the edge networks 14, 16 (Borella et al., Figure 1), which the Examiner has found to be analogous to the LAN 1 of the claimed invention, as discussed above in connection with the rejection of Claims 1 and 10 under 35 U.S.C. § 103(a). (Office Action at 5) By contrast, the control circuit 110 of Claim 8 is part of the telephone controller 100, which is inside the LAN 1, between the router 3 and the LAN-connected telephone 200. (Figure 8) Applicant thus submits that Claim 8 is patentable over Borella et al.

Claim 9. The Examiner has found dependent Claim 9 to be unpatentable over Borella et al. because "Borella discloses the limitation of the transfer circuit which transfers information stored in the table to some other telephone controller in the

gatekeeper setup message 92 of Figure 3. As described in lines 45-52 of column 8, this message includes caller and callee identification information (stored in the table) from one telephone controller (first gatekeeper) to another telephone controller (second gatekeeper)." (Office Action at 7) By use of the transfer circuit, the claimed invention permits information stored in the table 131 to be sent from one telephone controller 300 to another telephone controller 400. The table 131 and the telephone controllers 300, 400 of Claim 9 are not analogous to the first and second gatekeepers or other features discussed in Borella et al. The features of Figure 3 of Borella et al. discussed by the Examiner relate to information exchanged between the first and second gatekeepers, which is information that remains outside either the first or second network. Claim 9, by contrast, relates to the transfer for information from a telephone controller 300 within a LAN 1 to another telephone controller 400 (which may or may not be within the firewall of another LAN) connected to the Internet 2. (Figure 9) Applicant thus respectfully submits that Claim 9 is patentable over Borella et al.

<u>Rejection of Claims 4-5 and 7 Under 35 U.S.C. § 103(a)</u>

The Examiner has rejected Claims 4-5 and 7 under 35 U.S.C. § 103(a) as unpatentable over Borella et al. in view of Beser et al. and further in view of Chimura et al. Applicant respectfully traverses on the basis that the combination of Borella et al. with Beser et al. and Chimura et al. would not result in the claimed invention. In addition, the Examiner's assertion of obviousness with regard to Claims 4 and 5 appears to be based on impermissible hindsight.

As noted above, the claimed invention is directed to the problem *inter alia* that a LAN-connected telephone may be unable to receive a call directly from an external telephone connected to the Internet, even if the caller using the external telephone knows the private IP address of the internal telephone within the LAN, because the operation of the LAN's security firewall may prevent external telephones from directly addressing telephones connected to the LAN. Chimura et al. appears to lack any discussion of security or firewalls and does not address the difficulty of penetrating a security firewall to directly address, or call, a LAN-connected telephone from outside the LAN. Chimura et al. is directed to a telephone communication method capable of relating a telephone terminal and a speech channel IP address at the time of call connection. To this end, Chimura provides that when a call is

originated on a first telephone terminal 11, a first gateway 12 accommodating the terminal accesses a DNS (Domain Name System) server 16 of the Internet or an Intranet 13. The first gateway 11 queries the DNS server 16 for the IP address of a second gateway 14 accommodating a telephone terminal 15 to be called, using an office number assigned to the second telephone terminal 15 as a host name. The DNS server 16 returns the IP address of the second gateway 14 to the first gateway 12. In response, the first gateway selects its own IP address for speech transfer and sends a call connection request to the second gateway 14. On receiving the request, the second gateway 14 determines whether or not the second telephone terminal 15 is busy, and selects the IP address for speech transfer if it is idle. The IP address selected is returned to the first gateway 12 in the form of a response message. As a result, Chimura et al. provides for an IP connection to be set up between the two telephone terminals.

Claim 4. The Examiner has found dependent Claim 4 to be unpatentable over Borella et al. in view of Beser et al. and further in view of Chimura et al. on the basis that "Chimura discloses the limitation of identification information being composed of a user name (host name) and extension telephone number (office number) in lines 52-54 pf column 5." (Office Action at 7) Applicant respectfully traverses on the basis *inter alia* that a user name, which identifies an individual user or user account, is not analogous to a host name, which identifies a host computer or server on which users may have accounts. Thus, Chimura et al. provides names of cities such as Tokyo and Osaka as examples of host names (Chimura et al., Figure 4) and further identifies such host names with PBXs 11A, 15A rather than individual telephones (Chimura et al., column 7, lines 34-40), while the claimed invention provides the personal name of Kobayashi as an example of a user name. (Figure 5) Applicant further traverses on the basis *inter alia* that the "office number" of Chimura et al. does not appear to be analogous to the extension telephone number 301 of the claimed invention, since Chimura et al. draws a distinction between an "office number" and an "extension number." (Chimura et al., column 7, lines 50-61) In addition, where use is made in Claim 4 of identification information consisting of a user name 300 and extension telephone number 301, it is done in connection with providing a solution to *inter alia* the problem of enabling telephones 200, 201 connected to a LAN 1 to receive direct calls from an outside telephone 510 connected to the Internet 2. That

problem is not addressed by Chimura et al. any more than it is by Borella et al. or Beser et al. Thus, the Examiner appears to be engaging in impermissible hindsight in reaching what amounts to a conclusion that it would be obvious in view of Borella et al., Beser et al., and Chimura et al. to arrive at Claim 4, which provides a solution to a problem that is not recognized by any of the three references. Applicant thus respectfully submits that Claim 4 is patentable over Borella et al., Beser et al., and Chimura et al.

Claim 5. The Examiner has found dependent Claim 5 to be unpatentable over Borella et al. in view of Beser et al. and further in view of Chimura et al. on the basis that "Chimura discloses the limitation of the table including additionally a user name (host name) and extension telephone number (office number) in Figure 4." (Office Action at 8) As discussed above in connection with Claim 4, Applicant respectfully traverses on the basis *inter alia* that "host name" as used in Chimura et al. does not appear to be analogous to user name 300 in the claimed invention, and "office number" as used in Chimura et al. does not appear to be analogous to the extension telephone number 301. In addition, where use is made in Claim 5 of a table 131 indicating a correspondence among the ID 412, private IP address, extension telephone number 301 and user name 302, it is done in connection with providing a solution to *inter alia* the problem of enabling a telephone 200 connected to a LAN 1 to receive direct calls from an outside telephone 510 connected to the Internet 2. That problem is not addressed by Chimura et al. any more than it is by Borella et al. or Beser et al. Thus, the Examiner appears to be engaging in impermissible hindsight in reaching what amounts to a conclusion that it would be obvious in view of Borella et al., Beser et al., and Chimura et al. to arrive at Claim 5, which provides a solution to a problem that is not recognized by any of the three references. Applicant thus respectfully submits that Claim 5 is patentable over Borella et al., Beser et al., and Chimura et al.

Claim 7. The Examiner has found dependent Claim 7 to be unpatentable over Borella et al. because "Borella discloses the limitation of the table being updated in response to a request from the telephone in Figure 3." (Office Action at 8) A review of Figure 3 of Borella et al., however, does not reveal anything potentially analogous to the updating of a table. In addition, as discussed above in connection with Claims 1-3, 6, and 8-11, the table 131 of the claimed invention is part of a telephone

controller 100 which is paced inside a LAN 1 between the router 3 and a telephone 200 connected to the LAN 1. (Figure 8) There is no analog to the telephone controller 100 of the claimed invention, or parts such as the table 131 of Claim 7, in Borella et al., because the architecture of Borella et al. provides for actions such as address allocation and lookup to be performed between a router and a back end server (Borella et al., Figure 3), which is outside the edge network (Borella et al., Figure 1), which the Examiner has found (Office Action at 5) to be analogous to the LAN 1 of the claimed invention. Thus, any functionality of Borella et al which the Examiner may have found to be analogous to the table 131 of Claim 7 is distinguishable on the basis that the table 131 of Claim 7 is a part of the telephone controller 100 (Figure 7), which is inside the LAN 1 (Figure 8), while the architecture of Borella et al. provides that address-handling functions are to be found outside the edge network (Borella et al., Figures 1 and 3). Applicant thus respectfully submits that Claim 7 is patentable over Borella et al.

Conclusion

In view of the foregoing, it is respectfully requested that the application be reconsidered, that Claims 1-11 be allowed, and that the application be passed to issue. Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of

fees for the petition or for entry of this amendment to Attorney's Deposit Account
No. 50-2041 (Whitham, Curtis & Christofferson P.C.).

Respectfully submitted,

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